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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,211	10/21/2003	James Spitler	65677/P001US/10311263	2328

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DALLAS, TX 75202

EXAMINER

HOFFMAN, MARY C

ART UNIT	PAPER NUMBER
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3733

MAIL DATE	DELIVERY MODE
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06/14/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/690,211

Applicant(s)

SPITLER ET AL.

Examiner

Mary Hoffman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25,26,29 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25,26,29 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/21/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>05/04/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Allowable Subject Matter

Upon further consideration of the claims due to claim amendments, the indicated allowability of claim 25 and dependents is withdrawn. Rejections follow.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 26 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has amended claim 26 to recite that the "pair of bearings...each of the pair of bearings interfacing with an indentation" is part of the means for pivoting; however, this appears to be new matter because it is not described in the specification that the bearings and indentation make up the means for pivoting. Rather, it previously appeared that the "indentation" was part of the "means for slidably adjusting the means for pivoting", and the "means for pivoting" was to be solely the pair of bearings. HOWEVER, upon further review of the specification, the examiner now asserts that the "means for pivoting" is actually tool 1200 in FIG. 12A (see

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specification, pages 7-8, paragraph [0041]). If Applicant's intention is to claim the pair of bearings in claim 25 and not tool 25, it would be clearer if Applicant recites "means for facilitating pivoting" as it is stated in the specification, see page 10, paragraph [0052]). If Applicant's intention is to claim the pair of bearings as well as the indentation as the means for facilitating pivoting, then Applicant is required to point out to the examiner what the "means for slidingly adjusting the means for pivoting" is and where this feature is described in the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 25-26, 29 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As discussed above, the claims are currently confusing and insufficient to point out and distinctly claim the subject matter of the invention. There is confusion as to what the "means for pivoting" is referring to. The examiner does not understand whether or not Applicant is trying to claim the pair of bearings as the means for pivoting. If Applicant wants to claim the means-plus-function language in claim 25 as referring to the pair of bearings, Applicant should amend the claim to recited "means for facilitating pivoting" or a similar phrase that is supported by the disclosure. Currently, the "means for pivoting" cannot be considered the pair of bearings and indentation, as recited in claim 26, since the "means for pivoting" appears to actually be tool 1200 (see above, which performs the pivoting function. Furthermore, in light of Applicant's amendment to

claim 26 (stating that the indentation is part of the means for pivoting), the examiner does not understand what feature is being described by the phrase "means for slidingly adjusting the means for pivoting". Applicant should clearly state on the record what structural features of the invention are being claimed by the means-plus-function, 112th 6th paragraph language that is being invoked, and where in the specification these structural limitations are described.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 25, 29 and 30, as best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Boehm, Jr. et al. (U.S. Patent Applicant no. 2004/0039384).

Boehm, Jr. et al. discloses a medical implant (FIG. 12) comprising a first bone anchor; a second bone anchor; and a brace comprising. The device comprises means for pivoting the brace from a first position to a second position (ref. #120, paragraph [0059]), wherein in the second position the brace couples the first bone anchor to the second bone anchor; means for slidingly adjusting the means for pivoting along at least a portion of the longitudinal length of the brace (spring-loaded, ref. #128, 130); and

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means for transmitting torque between the brace and at least one of the first and second bone anchors (ref. #68). The medical implant further comprises a receptacle (ref. #60); and means for polyaxially attaching the receptacle to the head of the second bone anchor (hole in the base of ref. #60); and wherein the receptacle comprises means for engaging with the brace (U-shaped channel). The medical implant further comprising means for locking the brace and the anchors in a fixed relationship with each other (ref. #78).

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Hoffman whose telephone number is 571-272-5566. The examiner can normally be reached on Monday-Friday 9:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MCH


EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER